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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT PAPER NUMBER

2635

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/169,839

Applicant(s)

HINDUS ET AL.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

EXAMINER'S RESPONSE

1. In response to applicant's amendment filed 9-4-02, all the amendments to the specification and claims have been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out the support in the specification as originally for the limitations "wherein said indication comprises a message programmed into the receiving device by a programming individual other said second individual" in claims 1 and 27, the limitation of "wherein the programming individual is the first individual" in claims 43 and 46, nor the limitation of "wherein the message is programmed into the receiving device prior to the presence signal is sent from the transmitting device" in claims 44 and 47.

Claim Rejections - 35 USC § 102 & 103

4. The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

5. Claims 1-2, 4-6, 7-10, 22, 27-28, 30-33 43-44 and 46-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Richardson (US 5459458).

Richardson discloses a two way paging system as claimed. In view of page 8 of applicant's specification, "call back" in the message of Fig. 7, or any paging message corresponds to a presence signal. See the entire document. Col. 11 line 54 - col. 12 line 13 disclose pre-recorded messages entered or programmed by a subscriber (1st user) to be presented to an originator (2nd user).

6. Claims 1-2, 4-6, 7-10, 19-24, 27-28, 30-33, 38-41 43-44 and 46-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Will (US 5479408).

Will discloses a two way paging system as claimed. In view of page 8 of applicant's specification, the acknowledgments, responses, original messages, location tracking, or any paging message corresponds to a presence signal. See the entire document. Preprogrammed messages and responses can be defined by a user to be presented to another user as an original message or a response. See for example, Col. 5 lines 14-31, col. 16 lines 48-61, col. 19 lines 35-53, col. 16 line 20 - col. 28 line 36 and col. 36 line 61 - col. 37 line 35.

7. Claims 1-2, 4-6, 7-10, 22, 27-28, 30-33 43-44 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) as applied above in combination with Ise (US 5257307). Ise discloses an analogous art paging system and method where canned messages are stored on memory cards of two transceivers. Canned messages programmed onto one card are copied to second card so that

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messages programmed by a first user are stored in the memory of the second device.

See col. 7 lines 37-44 This provides advantages such as permitting secret communication, reducing the amount of data transmitted and the number of key operations. If Richardson does not clearly disclose the first user programming the message into the receiver then such would have been obvious in view of the copying of the memory card of Ise for advantages such as permitting secret communication, reducing the amount of data transmitted and the number of key operations

8. Claims 1-2, 4-6, 7-10, 19-24, 27-28, 30-33, 38-41, 43-44 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Will (US 5479408) as applied above in combination with Ise (US 5257307). Ise discloses an analogous art paging system and method where canned messages are stored on memory cards of two transceivers. Canned messages programmed onto one card are copied to second card so that messages programmed by a first user are stored in the memory of the second device. See col. 7 lines 37-44 This provides advantages such as permitting secret communication, reducing the amount of data transmitted and the number of key operations. If Will does not clearly disclose the first user programming the message into the receiver then such would have been obvious in view of the copying of the memory card of Ise for advantages such as permitting secret communication, reducing the amount of data transmitted and the number of key operations

9. Claims 3, 23-24, 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) or Will (US 5479408) alone or in view of Ise (US 5257307) as applied above and further in view of LaPorta (US 5959543) .

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LaPorta discloses an analogous art two way paging system with group call message modification (abstract, col. 14) and it would have obvious to have included such in the Richardson or Will to provide a more advanced set of transaction services.

10. Claims 11, 14-16, 18, 34-37, 42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) or Will (US 5479408) alone or in view of Ise (US 5257307) as applied above and further in view of Segal (US 5644627) and Poland (US 5401947).

Segal discloses an analogous art two way paging system with indication by audible or voice message, visual LED or LCD, or tactile signal (cols. 4-5). Tactile is vibratory or haptic motion. Poland discloses an analogous art selective indicator with heated (thermochromic) liquid crystal ink markings printed on a display. It would have obvious to have included such indicators in the Richardson or Will to provide the user the convenience and flexibility of selecting from the various indicator modes and the heated LCD is suggested by Richardson indicating use of any well known visual display such as LCD in col. 7 and will showing LCD in col. 4A.

11. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) or Will (US 5479408) alone or in view of Ise (US 5257307) in view of Segal (US 5644627) and Poland (US 5401947) as applied above and further in view of Easterling (US 5651049).

Easterling discloses an analogous art paging system with a receivers embedded in objects such as stuffed animals and it would have been obvious to have included such in the combination applied above in order to relate the receiver to the

corresponding user or message recipient.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) or Will (US 5479408) alone or in view of Ise (US 5257307) in view of Segal (US 5644627) and Poland (US 5401947) as applied above and further in view of McLaughlin (US 4975694).

McLaughlin discloses an analogous art paging receiver with a multiple color LED or lamp indicator and it would have been obvious to have included such in the combination applied above in order to provide multiple indications with a single lamp.

13. Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) or Will (US 5479408) alone or in view of Ise (US 5257307) in view of Segal (US 5644627) and Poland (US 5401947) as applied above and further in view of Park (US 5733131).

Park discloses an analogous art paging receiver with a mechanical control such as movement of the mouth of a stuffed animal (fig. 2) and telephone input to the paging system (fig. 1). It would have been obvious to have included such in the combination applied above in order to provide inexpensive educational and/or entertainment device.

14. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) or Will (US 5479408) alone or in view of Ise (US 5257307) as applied above in view of Shapira (US 5086394).

Shapira discloses an analogous art paging system with matched pairs and it would have been obvious to have included such match pairs in the combination applied above in order to provide introduction of users.

15. Claims 19-21 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Will (US 5479408) alone or in view of Ise (US 5257307) as applied above or further in combination with Richardson (US 5459458).

Will discloses transceiver in figs. 4A-4C which is considered to be a picture frame because it holds a photo ID 46. This frame includes a touch sensitive switch or key 48. A relay station is shown in figs. 6A-6C and 8A-8B to include a picture frame discussed on pages 11-12, and if it is not clear that the transceiver is a with key 48 is a frame then it would have been an obvious various in location of parts or obvious integration of parts to have combined transceiver with key 48 and the picture frame for user input. It further would have been obvious to have included this frame in the system of Richardson in order to identify the user or to blend into the environment.

Response to Arguments

16. Applicant's arguments filed 9-4-02 have been fully considered but they are not persuasive and/or are moot in view of new grounds of rejection. Applicant's argument that the prior art lacks message programmed by other than the individual at the receiver is not persuasive in view of Richardson including messages prerecorded by the subscriber and played back by the originator and Will disclosing user defining of preprogrammed messages and response to be presented at another device. Further, the amendments necessitated new grounds of rejection under 35 USC 112 first paragraph for new matter and under 35 USC 103 relying on Ise to show copying of prerecorded or canned messages from the memory of a first device to memory of a second device.

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Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


CONTACT INFORMATION

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology center 2600 receptionist whose telephone number is **(703) 305-4700**.

Facsimile submissions may be sent via fax number (703) 872-9314 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30:-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704.

EH
11/29/02


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635